

### **REMARKS**

This responds to the Office Action mailed on June 27, 2005, the references cited therewith, and a telephone interview with Examiners Timothy Harbeck and Hyung Sough on September 7, 2005.

Claims 1-20 and 22 are amended, claims 21 and 23-29 are canceled, and claim 30 is added; as a result, claims 1-20, 22, and 30 are now pending in this application.

#### **Drawing Objections**

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(4) and 37 C.F.R. 1.84(p)(5). Specifically the drawings were objected to for including a reference character 20 that has been used to designate both a search server and a buyer's request (specification, page 13) and further objected to for including a reference character 513 not mentioned in the specification. In response to the first objection, the paragraph 29, beginning at page 12, was amended to recite "200" instead of "20." In response to the second objection, the Paragraph 36, beginning at page, 16 was amended to include the phrase, "includes a description (513) that describes an exemplary "Buy It Now" feature that provides..."

#### **§101 Rejection of the Claims**

Claims 10-15 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response to this objection the independent claim 10 has been amended, in the body of the claim, to recite "receiving" as performed "at a computer system." Dependent claims 11-15 depend on the independent claim 10. Accordingly, the objection to these dependent claims is addressed by the amendment to independent claim 10.

#### **§103 Rejection of the Claims**

Claims 1-16, 23 and 25-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,202,051 (hereinafter Wolston) in view of Hof et al. (eBay vs. Amazon.com, May 31, 1999, Business Week, pg.128; hereinafter Hof).

Applicant respectfully submits that claims 1-16, 23 and 25-26 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitations:

presenting, via a first computer system, both an auction purchase process and a fixed-price purchase process for purchase of an offering to a buyer; and

responsive to receipt of a bid from the buyer as part of the auction purchase process, removing the presentation of the fixed-price purchase process.

The Office Action contends that the above limitations are obvious when combining Woolston and Hof. Specifically, the Office Action notes that Hof describes “adding fixed prices to their auctions.” With regard to adding fixed prices to auctions the Applicant notes that Hof describes the following:

“ebay is mulling fixed prices”

Hof, Page 2, paragraph 1.

“And eBay recently polled members on whether they’d like to see fixed – price auctions.”

Hof, Page 4, paragraph 3.

It’s [eBay] also mulling fixed – price auctions and dealer storefronts to offer a wider range of products and pricing choices.

Hof, Page 9, bottom of page.

The above quotes from Hof describe eBay as mulling or considering fixed-price auctions. Hof does not provide a description of a fixed-price auction. Applicant has carefully read Hof and believes there is no mention of both auctions and fixed pricing in Hof.

Claim 1 requires presenting both an auction purchase process and a fixed-price purchase process and removing the presentation of the fixed-price purchase process in response to receiving a bid from a buyer.

In contrast, the above quotes from Hof do not describe removing the presentation of a fixed-price purchase process in response to receiving a bid from a buyer; but rather, eBay as mulling fixed prices. Indeed, the Hof article, for the most part, compares the competitive strategies of eBay and Amazon (e.g., title, eBay vs. Amazon.com) and does not describe a presentation of both an auction purchase process and a fixed-price purchase process, much less the removal of the presentation of the fixed-price purchase process in response to receiving a bid from a buyer. Hof therefore neither teaches nor suggests the above identified limitation of claim 1.

The above remarks are also applicable to a consideration of independent claims 10, 20 and 23.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-9, 11-16, and 24-26 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 17-19 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woolston in view of Hof as applied to claim 16 and 23 above, and further in view of eBay ([http://web.archive.org/web/\\*/http://www.ebay.com](http://web.archive.org/web/*/http://www.ebay.com), Date: 11/27/99, Category: Toys, Bean Bag Plush: Action Figures: General; hereinafter Webpage). Claims 17-19 depend on independent claim 10 therefore the rejection of rejection of claims 17-19 under 35 U.S.C. § 103 is also addressed by the above remarks. Claims 27-29 have been cancelled therefore the rejection is moot.

Claims 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,058,417 (hereinafter Hess) in view of Hof. The above remarks are applicable to a consideration

of independent claim 20. Claims 21-22 depend on independent claim 20 therefore the rejection of claims 21-22 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Woolston in view of Hof as applied to claim 23 above, and further in view of Hess. Claim 24 has been cancelled therefore the rejection is moot.

In summary, Woolston in combination with Hof in combination with Webage in combination with Hess does not teach or suggest each and every limitation of claims 1, 10, 20 and 23 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

REED MALTZMAN

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
408-846-8871

Date 11/2/2005

By Mark R. Vatuone  
Mark R. Vatuone  
Reg. No. 53,719

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2 day of November, 2005.

Peter Rebuffoni

Name

Peter Rebuffoni  
Signature